

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.:	10/728,683	§	Confirmation No.:	9079
Applicant:	Michael J. Gauer	§		
Filed:	12/05/2003	§		
TC/A.U.:	2625	§		
Examiner:	Ashish Thomas	§		
Title:	PRINTED DOCUMENT IDENTIFICATION	§ §		
Docket No.:	200901536-1 (HPC.0870US)	§ §		

Mail Stop Appeal Brief-Patents

Commissioner for Patents

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REPLY BRIEF

Sir:

The following sets forth Appellant's Reply to the Examiner's Answer dated May 27, 2010.

A. REPLY TO EXAMINER'S ANSWER REGARDING THE § 103 REJECTION OF CLAIMS 7, 10-13, 24, 27, 28, 31, 38 OVER BREWSTER, JOHNSON, AND PHANG

The Examiner's Answer conceded that Brewster and Johnson fail to disclose the bolded language in the following clause of claim 7:

wherein formatting a page to be printed comprises **checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins.**

Examiner's Answer at 21. The Examiner's Answer also conceded that Phang also fails to disclose the foregoing "checking" element of claim 7. *Id.* However, despite such concessions,

the Examiner's Answer argued that the hypothetical combination of Brewster, Johnson, and Phang somehow achieves the claimed subject matter.

Appellant respectfully disagrees. As noted by the Examiner's Answer (on page 20), Brewster discloses that an identification mark can be printed in a margin anywhere. Brewster, 3:28-30. Johnson was cited by the Examiner as disclosing the "accessed information" associated with the sender in claim 7—however, Johnson provides no hint of providing this accessed information in a space between document data areas and printer allowable margins. According to the Examiner's Answer, the combined teachings of Brewster and Johnson disclose "accessing information associated with a sender of the document data; and formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information, and the accessed information is located outside document data area and inside printer allowable margins." Examiner's Answer at 21.

Thus, what is missing in Brewster and Johnson is the "checking" performed in claim 7, as noted above. The Examiner's Answer argued that Phang discloses "the ability to check whether the entire work area as defined by user-selected margins are within printer boundaries" *Id.* The Examiner's Answer then concluded that it "follows that the combination of Brewster, Johnson, and Phang obviously realizes 'checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins'." *Id.*

Phang's teachings do not lead to the conclusion made in the Examiner's Answer. Column 1 of Phang refers to a work area on a page that is specified by a set of left, right, top and bottom margins. Phang, 1:40-41. Phang states that if the work area falls within the printable area of the medium, the work produced in the work area can be printed completely on the medium. *Id.*, 1:50-52. However, Phang states that if the work area encroaches on the

unprintable area, the part of the work which lies in the unprintable area will not be printed. *Id.*, 1:52-53. According to Phang, an application verifies “user-selected margins with the reported boundaries [reported from a printer].” *Id.*, 1:62-64. In Phang, the checking that is performed is checking whether user-selected margins encroach and pass a boundary into an unprintable area of a medium. Determining whether user-selected margins exceeds a boundary that defines a printable area of a printer, as taught by Phang, does not lead to “checking whether the accessed information [associated with a sender of document data] for the formatted page **fits between** the document data areas and the printer margins,” as recited in claim 7.

In fact, Phang assumes that extra information such as headers, footers, and line numbers are included within the work area defined by the user-selected margins. Thus, Phang would have absolutely no desirability or need to check whether accessed information associated with a sender of document data can fit between document data areas and print allowable margins, since what Phang does is to check whether the entire work area as defined by user-selected margins are within printer boundaries, which is fundamentally quite different from the subject matter of claim 7.

The Examiner argued that the “use of the Phang reference in the rejection qualifies as one of the rationales—applying a known technique to a known device (method or product) ready for improvement to yield predictable results—for [combining] references as outlined in *KSR v. Teleflex*.” *Id.* At 21-22.

The “known technique” of Phang is to check whether user-selected margins encroach and pass a boundary into an unprintable area of a medium. The “known technique” of Phang is **not** checking whether the accessed information [associated with a sender of document data] for the formatted page **fits between** the document data areas and the printer margins, as claimed.

Therefore, applying the “known technique” of Phang into the combined system of Brewster and Johnson would still not have led to:

wherein formatting a page to be printed comprises checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins.

The Examiner’s Answer also does not accurately characterize the teachings of Phang when the Answer stated that Phang “teaches the ability to check if data fits within certain boundaries (column 2, lines 15-55).” Examiner’s Answer at 22. What Phang actually teaches is checking whether user-selected margins encroach and pass a boundary into an unprintable area of a medium. Therefore, it is clear that Phang would not have led a person of ordinary skill in the art to checking whether the accessed information [associated with a sender of document data] for the formatted page fits between the document data areas and the printer margins.

In view of the foregoing remarks and in view of the arguments presented in the Appeal Brief, it is clear that the foregoing claims are non-obvious over the cited references.

B. CONCLUSION

The remaining arguments made in the Examiner's Answer have either been rebutted above or have already been rebutted in the Appeal Brief. In view of the foregoing arguments and the arguments presented in the Appeal Brief, reversal of all final rejections is respectfully requested.

Respectfully submitted,

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